

The opinion in support of the decision being entered today was ***not*** written for publication and is ***not*** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex Parte STEPHEN CUTLER
and PAUL A. VERWER

Appeal No. 2004-0787
Application No. 09/827,048

ON BRIEF

Before OWENS, WALTZ and JEFFREY T. SMITH, *Administrative Patent Judge*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

Decision on appeal under 35 U.S.C. § 134

Applicants appeal the decision of the Primary Examiner's refusal to allow claims 33 to 39, 42, 44 and 48 to 50.¹ We have jurisdiction under 35 U.S.C. § 134.²

¹ The Examiner has indicated that the subject matter of claims 40 and 47 is allowable. (Final Rejection, p. 4).

² In rendering this decision, we have considered Appellants' arguments presented in the Brief filed November 18, 2002, the Supplemental Brief filed May 13, 2003 and the Reply Brief filed August 11, 2003.

THE INVENTION

According to Appellants, the claimed invention relates to an electrical connector for “electrically and mechanically connecting a plurality of wires or other types of electrical conductors in a quick, secure and reliable manner.” (Brief, p. 2).

The scope of the appealed claims can be ascertained from representative claim 39 reproduced from the Brief below:

39. A locking connector for electrically interconnecting two or more electrical conductors comprising:

an electrical contact component electrically interengaged with a first conductor, said contact component being made of metal sheet material having a contact section, another section in parallel spaced relation from said contact section, an intermediate section that interconnects one end of each of said contact section and said another section, an opening extending through said intermediate section that receives a second conductor, and an intumed lip integral with said contact section in axial spaced relation from said opening in said intermediate section that acts as a stop for said second conductor when inserted through said opening in said intermediate section;

at least one spring locking clip that is spring biased to grip the second conductor and hold the second conductor in electrical interengagement with said contact section, while resisting disengagement of the second conductor from said contact section; and

a release hole formed through said contact section transversely offset from said opening for receiving a clip release element, said clip having a portion extending transversely outward of said opening in line with said release hole for engagement by the clip release element upon insertion of the clip release element into the release hole to urge said

clip into an open condition to permit unobstructed insertion and removal of the second conductor into and out of said contact component.

CITED REFERENCES

As evidence of unpatentability, the Examiner relies on the following references:

Kubota et al. (Kubota)	4,673,232	Jan. 16, 1987
Gelati	4,768,976	Sep. 06, 1988
Tozuka	5,454,730	Oct. 03, 1995

The Examiner rejected claims 33-37, 39, 44 and 48-50 under 35 U.S.C. § 103(a) as obvious over the combination of Tozuka and Gelati; claim 38 under 35 U.S.C. § 103(a) as obvious over the combination of Tozuka and Kubota; and claim 42 under 35 U.S.C. § 103(a) as obvious over the combination of Tozuka and Gelati, as applied to claim 39, further combined with Kubota.³ (Paper no. 13, pp. 2-4).

We have carefully reviewed the claims, specification and applied prior art, including all of the arguments advanced by both the Examiner and Appellants in support of their respective positions. This review leads us to conclude that the

³ The Examiner has inadvertently excluded the statement of the rejection of claim 42 in the Answer, page 2. However, the Examiner does provide a discussion of this rejection in response to Appellants' arguments on pages 4 and 5 of the Answer.

rejections of claims 33-37, 38, 39, 42, 44 and 48-50 are not well founded. Our reasons follow.

OPINION

Claims 33-37, 39, 44 and 48-50

We reverse the rejection of claims 33-37, 39, 44 and 48-50. We need to address only the independent claims, i.e., claims 39 and 44. In rejecting the subject matter of claims 39 and 44, the Examiner's relies on the combination of Tozuka and Gelati.

To hold an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the reference teachings and combine them in a way that would produce the claimed invention. *See, e.g., Heidelberg Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) (When the patent invention is made by combining known components to achieve a new system, the prior art must provide a suggestion, or motivation to make such a combination.); *Northern Telecom v. Datapoint Corp.*, 908 F.2d 931, 934, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990) (It is insufficient to establish a *prima facie* case of obviousness based on prior art references disclosing the components of a patented device, either separately or used

in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor.); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1044, 1051, 5 USPQ 1434, 1438 (Fed. Cir. 1988).

The Examiner rejected claims 39 and 44 over the combination of Tozuka and Gelati. According to the Examiner, “Tozuka when modified by Gelati does not uses [sic, use] the inturned lip integral with the contact section that acts as a stop for the second conductor”. (Final Rejection, p. 2). The Examiner asserts that it would have been “obvious and cost-effective to manufacture the end portion of the end of the Tozuka’s holder (11) flush with the portion (33) of the contact component (21) to reduce the overall dimensions of the connector.” (Final Rejection, p. 2).

We cannot uphold the Examiner’s rejection. Appealed claims 39 and 44 require the contact component to include an opening extending through an intermediate section that receives a second conductor, and an inturned lip integral with the contact section in axial spaced relation from said opening in the intermediate section. The inturned lip acts as a stop for the second conductor when inserted through said opening in the intermediate section.

The modification of Tozuka’s holder (11) to be flush with the portion (33) of the contact component (21) would not result in the claimed invention. Specifically,

Tozuka's contact component (21) would not have the claimed structure, i.e., an inturned lip, that is required by the contact component of the claimed invention.

The Examiner has not directed us to adequate motivation or suggestion for modifying Tozuka's contact component to include an inturned lip, which is required by the contact component of the claimed invention. The Examiner has not explained why the modification of Tozuka's holder (11) would have resulted in a contact component comprising an inturned lip. The mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *See In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

Claims 38 and 42

The Examiner rejected claim 38 under 35 U.S.C. § 103(a) as obvious over the combination of Tozuka and Kubota; and claim 42 under 35 U.S.C. § 103(a) as obvious over the combination of Tozuka and Gelati, as applied to claim 39, further combined with Kubota.

The subject matter of claims 38 and 42 requires the spring locking clip to have a locking end portion that is transversely curved across the entire width of the end portion to conform to the profile of the second conductor. The Examiner relies on Kubota to describe this element of the claimed invention. Specifically the Examiner

asserts that Kubota discloses that the grip locking portion (1a) is transversely curved. (Citing figures 1 and 7). (Final Rejection, pp. 3 and 4).

We cannot uphold the Examiner's rejections. Figures 1 and 7 of Kubota show the end portion of element (1), i.e., element (1a), has a curved notch. There is no indication that the cutout notch portion of element (1a) is sufficient to conform to the profile of the second conductor as required by the claimed invention. The Examiner has not provided motivation for enlarging the notch portion, described by Kubota, to conform to the profile of the second conductor and using this enlarged notch portion in the connector of Tozuka. The mere fact that the prior art could be modified as proposed by the Examiner is not sufficient to establish a *prima facie* case of obviousness. *See Fritch, supra*.

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CONCLUSION

Based on our consideration of the totality of the record before us, we reverse the rejections for the lack of the presentation of a *prima facie* case of obviousness.

REVERSED

TERRY J. OWENS
Administrative Patent Judge

THOMAS A. WALTZ
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

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